REMARKS

Claims 1-8 are currently pending in the instant application. Claims 4 and 8 have been withdrawn from consideration. Claims 1-5 have been amended to delete non-elected subject matter. In light of the above amendments and remarks, claims 1-3 and 5-7 are under active consideration in this application. No new matter has been added.

Elections/Restrictions

As a preliminary matter, Applicants submit that claim 4, as now amended, falls with the elected generic concept. In light of the above amendments, Applicants respectfully request rejoinder of claim 4 with the elected group.

Objections to the Claims

Claims 1-3 and 5-7 are objected to as containing non-elected subject matter.

In response, Applicants have deleted non-elected subject matter. Accordingly, Applicants respectfully request that the Examiner withdraw the Objections to the claims.

Rejections under 35 USC § 103

Claims 1-3 and 5-7 are rejected under 35 USC §103(a) as obvious over WO 00/71512. The Examiner contends that Example 24 of WO 00/71512 "differs from the instantly elected invention in the value for G, but there are other preferred embodiments of the prior art invention which have the value for G as –CR7R8".

Applicants respectfully disagree with this rejection. While Applicants agree with the Examiner that the prior art does not disclose a specific species example which falls within Applicants' elected invention, Applicants submit that the subject matter of the present invention is in no way obvious in view of Example 24 of WO 00/71512, neither alone nor in combination with other embodiments disclosed in WO 00/71512.

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird,* 16 F.3d 380, 382 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."). Further, a reference

disclosing a large number of species cannot support a *prima facie* case of obviousness. Some motivation to select the claimed species or subgenus must be taught by the cited reference. See, *e.g.*, *Deuel*, 51 F.3d at 1558-1559 ("No particular one of these DNAs can be obvious unless there is something in the prior art to lead to the particular DNA and indicate that it should be prepared."). Applicants submit that the cited reference does not expressly teach a particular reason to select the claimed species.

Further, it is earnestly asserted that the structural similarities between the claimed compounds and those of the cited reference are not sufficient to support a case of *prima facie* structural obviousness. The essential difference between Example 24 WO 00/71512, and the compounds of the instant invention is the second substituent R2 at the phenylene group. The cited reference in no way teaches nor suggests the second substituent R2 at the phenylene group of the claimed compositions.

With respect to all the presently pending claims, Applicants submit, that for all the reasons detailed above, the cited reference cannot and does not make obvious the claimed compositions. Accordingly, the rejection based on Section 103 must be withdrawn.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that all of the objections and rejections have been overcome and must be withdrawn. Further, Applicants submit that the application is now in form for issuance and an early allowance is earnestly requested. If any issues remain, the Examiner is invited to telephone the Attorney at the number below.

Respectfully submitted,

Susan K. Pocchiari

Susan K. Pocchiari
Attorney for Applicant(s)
Reg. No. 45,016

Date: November 11, 2004
Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 798-5648